

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
Anand Krishnamurthy et al.	§	Group Art Unit: 3686
	§	
Application No.: 10/723,186	§	Examiner: Woods, Teresa S.
	§	
Filed: November 26, 2003	§	Confirmation No.: 9020
	§	
For: METHOD FOR PROCESSING A	§	Atty. Docket: 140348-1 SV/YOD/SIN
WORKFLOW FOR AUTOMATED	§	GEMS:0260
PATIENT SCHEDULING IN A	§	
HOSPITAL INFORMATION SYSTEM	§	

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March 30, 2010	/Steven J. Sinclair, Jr./
Date	Steven J. Sinclair, Jr.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final office action mailed on December 23, 2009, and the advisory action mailed on March 30, 2010, the appellants respectfully submit this pre-appeal brief request for review. This request is being filed concurrently with a notice of appeal of the examiner's improper rejections of claims 1-25 of the present application. In the final office action, the examiner rejected claims 1-25 under 35 U.S.C. § 112, second paragraph. In addition, the examiner rejected claims 1-25 under 35 U.S.C. § 103(a) as obvious in view of the combination of Campbell et al. (U.S. Patent No. 6,047,259) and Teshima (U.S. Patent No. 6,272,470).

The appellants respectfully submit that the examiner has not established a *prima facie* case of unpatentability of the instant claims, and has thus erred in rejecting these claims. Accordingly, the appellants respectfully request review of this application and the pending rejections by the panel. Certain representative examples of errors in the final office action are noted below. It will be appreciated, however, that the appellants reserve the right to point out further errors and provide additional explanation in future communications regarding errors evidenced in the present final office action.

Deficiencies of the Rejection of Claims 1-25 under 35 U.S.C. § 112, Second Paragraph

The appellants strongly disagree with the examiner's assertion that the term "exam specifications" is indefinite. More specifically, the appellants contend that one skilled in the art would understand the term "exam specifications" by its plain meaning as "the specifications by which an exam is to be performed." Furthermore, the appellants note that the specification of the present application clearly supports this interpretation. More specifically, the appellants contend that it is clear from the specification that "exam specifications" specify the manner in which an exam is to be performed, including "recommendations for the exams, settings, protocols, regions to be examined, and any other relevant details needed or useful in performing the exams in a manner desired by the referring physician." *See, e.g.*, Application, page 11, lines 1-7.

Deficiencies of the Rejection of Independent Claims 1, 11, and 14 under 35 U.S.C. § 103

The appellants contend that Campbell and Teshima fail to disclose "sending a request for ordering exams to be performed on a patient to a scheduler, the request being sent by a referring physician *in the form of a decision tree of exams to be performed on the patient*," as generally recited by independent claims 1, 11, and 14. In rejecting independent claims 1, 11, and 14, the examiner acknowledged that Campbell does not disclose these recited features. Rather, the examiner relied exclusively on Teshima for their teaching. In particular, the examiner cited "at least Fig. 6, column 4, lines 16-20, column 10, lines 34-48" and "at least FIG 6 and associated text in column 11, lines 8-17" as disclosing the recited features. However, the appellants contend that none of these passages from Teshima discloses that a referring physician sends a request for ordering exams *in the form of a decision tree of exams to be performed on a patient*.

Rather, the first passage merely states that an examination may be ordered based on a patient's main complaint and observed physical findings. In addition, the second passage merely describes the first few steps in the process of a physician entering consultation information into a portable patient identification card (e.g., does the information being input into the portable patient identification card relate to a first consultation or a subsequent consultation). Finally, the third passage merely describes how contents of the portable patient identification card may be read, previous consultation records may be listed, and a new consultation record may be created and updated. Nowhere in these three passages does Teshima even suggest that a physician sends a request for ordering exams *in the form of a decision tree of exams to be performed on the patient*.

Indeed, the appellants contend that Teshima is primarily directed to a system wherein healthcare-related information, such as examination and biomedical information, may be stored within a portable patient identification card, which may remain in the possession of the patient most of the time. However, Teshima does not disclose the use of requested exams *in the form of a decision tree of exams to be performed on the patient*. For instance, Figure 6, relied upon by the examiner, merely discloses a process by which the portable patient identification card may be updated and maintained. For example, the process illustrated in Figure 6 represents steps that may be taken by a physician in entering consultation record information relating to a *single consultation* into the portable patient identification card for the patient (e.g., does the information being input into the portable patient identification card relate to a first consultation or a subsequent consultation). The appellants contend that the process illustrated in Figure 6 of Teshima clearly does not represent a *decision tree of exams to be performed on a patient*, as recited by independent claims 1, 11, and 14.

In addition, since Teshima fails to disclose the use of requested exams *in the form of a decision tree of exams to be performed on the patient*, the appellants further contend that Teshima cannot possibly disclose that additional exams are requested by an analyst *until an end of the decision tree is reached*, as recited by independent claims 1, 11, and 14.

In the Response to Arguments section of the final office action, the examiner stated that “both Campbell and Teshima’s systems and method provide deductive reasoning needed to make a decision and request medical examinations. A decision tree has no systematic logic, needed to make a decision. A doctor could simply utilize the resulting medical examinations of his/her patients to determine if additional medical examinations or doctor’s appointments are further needed.”

Therefore, it appears that the examiner, instead of identifying any passages in Campbell or Teshima that disclose the recited features, has merely attempted to downplay the significance of the recited features. More specifically, the examiner merely alleged an alternative to sending a request from a referring physician *in the form of a decision tree of exams to be performed on the patient*. In particular, the examiner alleged that “[a] doctor could simply utilize the resulting medical examinations of his/her patients to determine if additional medical examinations or doctor’s appointments are further needed.” The appellants contend that this is clearly insufficient to support a *prima facie* case of obviousness.

Deficiencies of the Rejection of Independent Claims 17, 24, and 25 under 35 U.S.C. § 103

The appellants also contend that Campbell and Teshima fail to disclose “generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams*,” as generally recited by independent claims 17, 24, and 25. Indeed, the appellants note that the examiner has provided no specific rationale as to why the hypothetical combination of Campbell and Teshima renders independent claims 17, 24, and 25 obvious. Rather, in the final office action, the examiner merely stated that “[c]laims 14-25 recite limitations that have been addressed in the claims above. Therefore, claims 14-25 are rejected for similar reasons.”

However, the appellants note that the claim language recited by independent claims 17, 24, and 25 is different than that recited by independent claims 1, 11, and 14, discussed above. Nevertheless, from the examiner’s statement, it can reasonably be assumed that the same rationale for rejecting independent claims 17, 24, and 25 is being used by the examiner as in the rejection of independent claims 1, 11, and 14. In particular, the appellants believe that the examiner contends that the Teshima reference discloses “generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams*” based on the same passages cited by the examiner with respect to the rejection of independent claims 1, 11, and 14.

However, as discussed above, the appellants contend that the passages of Teshima cited by the examiner merely disclose (1) that an examination may be ordered based on a patient’s main complaint and observed physical findings, (2) the first few steps in a process of assisting a physician in entering consultation information into a portable patient identification card (e.g., does the information being input into the patient identification card relate to a first consultation or a subsequent consultation), and (3) that the contents of the portable patient identification card may be read, previous consultation records may be listed, and a new consultation record may be created and updated. Nowhere in these three passages does Teshima suggest that a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams*, may be generated.

In the Response to Arguments section of the final office action, the examiner stated that “both Campbell and Teshima’s [sic] systems and method provide deductive reasoning needed to

make a decision and request medical examinations. A hierarchical listing of exams is simply any form of logic used to determine if additional medical examinations or doctor's appointments are further needed, while diagnosing or processing a prognosis."

Therefore, it appears that here again the examiner, instead of identifying any passages in Campbell or Teshima that disclose the recited features, has merely attempted to downplay the significance of the recited features. More specifically, the examiner alleged that "[a] hierarchical listing of exams is simply any form of logic used to determine if additional medical examinations or doctor's appointments are further needed, while diagnosing or processing a prognosis." However, the appellants contend that "logic used to determine if additional medical examinations or doctor's appointments are further needed" does not equate to generating a *hierarchical listing of exams to be performed in desired sequences, including exams desired before and after other exams based upon results of the exams*. Rather, the logic in Campbell and Teshima may be used to determine if a *single* medical examination or doctor's appointment is needed.

As such, at least in view of the above remarks, the appellants respectfully request that the panel instruct the examiner to withdraw the outstanding rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103 and allow the pending claims. If the panel believes that a telephonic interview will help resolve any remaining issues and help advance prosecution with respect to the present application, the panel is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: March 30, 2010

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